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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,072	02/09/2005	Arnoud Engelfriet	NL 020768	4228

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS  
P.O. BOX 3001  
BRIARCLIFF MANOR, NY 10510

EXAMINER
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HARPER, TRAMAR YONG

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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02/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/524,072	Applicant(s) ENGELFRIET, ARNOUD	
	Examiner Tramar Harper	Art Unit 3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/27/06</u>   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-9 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hannigan et al (US 2003/0037075).**

**Claims 1-2, 5, & 7:** Hannigan discloses toys and game applications that are enhanced with digital watermarks. Hannigan discloses a game console with input devices capable of decoding digital watermarks. The gaming device may interact with physical objects such as cards, stickers, product packaging, certificates, comic books, documents, emblems, game pieces, game cards, coupons, etc. The physical objects are embedded with digital watermarks. An input device of the gaming console captures an image or optical scan data from the physical object. The image/data is analyzed by decoding software within the gaming console to detect and decode the watermark. The watermarks include a payload or message. The payload provides a variety of information to enhance the gaming environment such as characters, game story form, abilities, levels, etc. Each digital watermark payload includes a unique identifier respective of a particular gaming feature such as character strength, ability, available tools, weapons and/or ammunition, spells, powers, energy, food supplies, available

resources, etc. A player can flash or change cards to interchange a character's abilities or resource inventory. Game manufacturers may sell or supply digitally watermarked cards for a particular game. Furthermore, the cards can be used to alter the gaming environment (background, cities, terrain, climate, settings, etc.) or story line (e.g. the watermark may trigger the execution of a predetermined block of software code, etc.) (embedded commands ¶¶ 133-152). Hannigan discloses an example wherein users can trade digitally watermarked music. One device plays a music clip and the second device captures the audio via a microphone extracts the digital watermark including ID and sends the ID to a database. The database looks up the song using the ID and then returns a file of the song to the user's device or to an online library of the user (¶ 130). Hannigan discloses a different form that comprises a game system that is designed to respond to digital watermarks embedded within audio and captured by a microphone (¶ 177). The above is interpreted as, although not explicitly stated, implying that the physical objects/cards of the gaming system can comprise of individual embedded audio watermarks with audio playback and a gaming console can comprise an input device or microphone capable of receiving the embedded audio watermarks.

However, in the alternative one of ordinary skill in the art at the time of the invention would be motivated to modify the gaming system of Hannigan such that the physical objects/cards of the gaming system can comprise of individual embedded audio watermarks with audio playback and a gaming console with an input device or microphone capable of receiving the embedded audio watermarks., for providing a

alternative form or design of an enhanced gaming environment, as suggested by Hannigan (see above).

**Claim 3:** Hannigan discloses, in the trading music example, that a first device plays a music clip including an embedded audio watermark and a second device captures the watermark including the ID, decodes it, and sends it to a database. The database then sends the corresponding song respective the music clip to the user's device (see above). This is interpreted as the sound comprising audio representative of the embedded command. A user receives/hears a clip of the song and therefore knows the song is the accessible or enabled feature.

**Claim 4:** Hannigan discloses the above with respect to Claim 1, but excludes the play back device arranged to play back the sound only a limited number of times. However, applicant has not disclosed that the play back device arranged to play back the sound only a limited number of times provides an advantage or solves a stated problem. Furthermore, Hannigan discloses that the gaming system can track the number of times a player uses a particular card e.g. the game console detects the card's audio watermark (§ 115). Furthermore, Hannigan discloses that a particular object representative of a gaming resource may correspond to a predetermined amount e.g. everytime the input device detects the watermark, the apparatus decrements the amount of the resource until exhausted (§ 168). One of ordinary skill in the art, furthermore, one would have expected Hannigan's collectable objects with audio play back, and applicant's invention, to perform equally well either the collectable objects with audio play back device, as taught by Hannigan, or the claimed play back device

arranged to play back the sound only a limited number of times because both provide the same function of allowing a player to exhaust the availability of a particular card or game element.

Therefore, it would have been prima facie obvious to modify Hannigan to obtain the invention as specified in claim 4 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Hannigan.

**Claim 6:** Hannigan discloses that the gaming system can track the number of times a player uses a particular card e.g. the game console detects the card's audio watermark (§ 115). Furthermore, Hannigan discloses that a particular object representative of a gaming resource may correspond to a predetermined amount e.g. everytime the input device detects the watermark, the apparatus decrements the amount of the resource until exhausted (§ 168).

**Claim 8:** Hannigan discloses that the collectable objects can be sold or supplied to players of a particular game (see above). Hannigan discloses that the invention can be extended to electronic business cards and promotional materials (§ 131, 150, 162).

**Claim 9:** Hannigan discloses the above with respect to Claim 5, but fails to disclose the apparatus repeats the sound upon the reception of the sound. However, applicant has not disclosed that the apparatus repeating the sound upon the reception of the sound provides an advantage or solves a stated problem. One of ordinary skill in the art, furthermore, one would have expected Hannigan's gaming console with input device, and applicant's invention, to perform equally well whether the apparatus not repeating

the sound upon the reception of the sound or the claimed does repeat the sound upon reception because both provide the same function of allowing a player to add a feature via an embedded audio watermark of a collectable object.

Therefore, it would have been prima facie obvious to modify Hannigan to obtain the invention as specified in claim 9 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Hannigan.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**McKinley (US 6,735,324) teaches a gaming system using digitally watermarked cards in an online environment.**

**Iwaki (US 6,947,893) teaches a system using audio embedded watermarks.**

**Chung (US 6,877,096) teaches a gaming system with collectable tokens that enable gaming features for a limited amount of use.**

**Hannigan (US 7,261,612) teaches a system that uses digital watermarks for story books.**

**Bruekers (US 2005/0021967) teaches a gaming system using embedded audio watermarks.**

**Petrovic (US 6,737,957) teaches a toy system using embedded audio watermarks.**

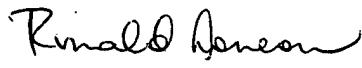
**Pearson (US 5,411,259), Garfield (US 5,662,332), Smith (US 5,533,124), and**

**Welander (US 5,743,801) teaches using trading cards in a gaming environment.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tramar Harper whose telephone number is (571) 272-6177. The examiner can normally be reached on 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Ronald Laneau  
Primary Patent Examiner  
Art Unit 3714

TH

01/28/08